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| 10/533,338 | 04/06/2006 | Benjamin Fuest | 3003-1078-1 | 9110 |
| 466 7590 09/18/2009 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314 | | | EXAMINER REESE, DAVID C | |
| | | | ART UNIT 3677 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,338

Applicant(s)

FUEST, BENJAMIN

Examiner

DAVID C. REESE

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13, 15 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 20-22 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12, 13 and 18 is/are rejected.
- 7) ☒ Claim(s) 8, 9 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 7/7/2009.

Status of Claims

- Claims 10-11, 14, and 16-17 were canceled.
- Claims 18-22 were added.
- Claims 1, 4-5, 9, 12-13, and 15 were amended.
- Claims 1-9, 12-13, 15, and 18-22 are pending.

Claim Objections

[1] Applicant has addressed all objections to the Claims in the amendment filed 7/7/2009.

Accordingly, all objections to the disclosure have been withdrawn by the Examiner.

However, as amended:

[2] Claim 13 recites the limitation "the components" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

In addition, in claims 5-8 and 18, "biasing device" should be "biasing member" per amended claim 1.

Claim Rejections - 35 USC § 112

[3] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 7/7/2009. Accordingly, the Examiner has withdrawn the 35 USC § 112 rejections.

Specification

[4] The abstract of the disclosure is objected to because no headings are present (see below). Correction is required. See MPEP § 608.01(b).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 102

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 1-3, 5-7, and 12-13 are rejected under 35 U.S.C. 102(b) as anticipated by DE 19605709, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, DE 19605709 discloses of a device (1, fig. 3) for fixing an object to a tree (2), the device (1) including:

an elongate body (1), one end of which elongate body (1) is adapted for attachment to a tree (2), the elongate body (1) being comprised of a plurality of elongate members (4, 8, 13, 11, 20, 22) removably joined together, and a length of the elongate body (1) being adjustable by an addition of another elongate member being joined to a terminal end of the joined elongate members (through the process of piecing together the body, additional elongate members are secured, therein making it longer),

an object (3) being slidably mounted on the elongate body (1), and

a biasing member (9) biasing the object (3) slidably mounted on the elongate body (1) towards the end of the body (1) adapted for attachment to the tree (2),

in use, pressure resulting from growth of the tree being transmitted to the object and pushing the object along the elongate body against the bias of the biasing member and away from the tree.

Re: Claim 2, wherein the elongate body (1) is adapted for attachment to a tree (2) by being fitted with a fixing member (4).

Re: Claim 3, wherein the fixing member (4) tapers to a sharp end point (12).

Re: Claim 5, wherein the biasing device (9) applies pressure that is usually slightly lower than that pressure resulting from expansion of a growing tree (2).

Re: Claim 6, wherein the biasing device (9) is formed of a resilient material.

Re: Claim 7, wherein the biasing device (9) comprises a compression spring.

Re: Claim 12, wherein the elongate members (1) are generally cylindrical.

Re: Claim 13, wherein the components forming the device are formed of plastics or metal material, such as stainless steel.

Claim Rejections - 35 USC § 103

[7] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[8] Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19605709.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 4 and 18, DE 19605709 discloses that of the above claims.

The difference between the claims and DE 19605709 is that DE 19605709 does not expressly disclose of the fixing member provided with a screw thread (at least in fig. 3) and of the specific range the biasing member applies. First, as shown in fig. 1 of DE 19605709, a fixing member has a screw thread. Thus, it would have been obvious to replace the fixing member from fig. 3 with that shown in fig. 1, as they are obvious equivalents, variations on means by which to attach the elongate body. Second, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to contrive any number of desirable ranges for the limitation disclosed by Applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Further, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Refer to MPEP § 2144.05.

Allowable Subject Matter

[9] Claims 15 and 20-22 are allowed.

[10] Claims 8-9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

[11] Applicant's amendment, see amendment and remarks filed, with respect to the rejection(s) of claim(s) under Baumgarten in view of Perkins, have been fully considered. Therefore, the rejection with regard to Baumgarten in view of Perkins has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of DE 19605709.

Conclusion

[12] THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[1] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./
Examiner, Art Unit 3677

/Victor Batson/
Supervisory Patent Examiner, Art Unit 3677